

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112 and in light of the remarks which follow.

Claims 1-11 are pending in the application, new claims 10 and 11 having been added above.

By the above amendments, the Abstract is replaced with the above new Abstract. Additionally, the claims are amended to address various §112, second paragraph, issues by removing unnecessary symbols. Claim 1 is further amended to insert the words --and mixtures thereof-- after the words "enhances the basicity of the π system." Claim 1 is further amended in this manner to address the §112, second paragraph, issue. Claim 1 is further amended by replacing the word "the" with the word --a-- to address the antecedent basis issue with respect to "the cationic entity." Claim 1 is further amended at line 22 by deleting the words "it being possible for said heterocyclic radical to comprise nitrogen or sulfur as heteroelements," to address the §112, second paragraph issue. Claim 1 is further amended at line 49 by replacing the word "or" with --and-- to address the §112 issue. Claim 1 is further amended at line 58 by replacing the words "additional conditions according to which" with the words --proviso that--, to address the §112 issue in line 58. Claim 1 is further amended at line 61 by deleting "Y¹:" and inserting --Y¹-- after the word "formula," to address the §112 issue with respect to the use of "Y¹." Claim 1 is further amended at line 76 by replacing the words "the possibility of being" with --are optionally-- to address the §112 issue in line 76. Claim 1 is further amended at line 79-80 by deleting

the words "cited with respect to" and by adding language so that the claim reads, in part, "... from the group of residues recited in the definition of Y⁴ ..." Claim 1 is further amended at line 83 to read, in part, "... and a monosulfonium species ..." Claim 1 is further amended at line 97 by deleting the word "and" and adding a comma (,). Claim 1 is further amended at lines 132-133 to read, in part, "... at least one reactive diluent selected from the group consisting of a nonorganosilicon, an organosilicon and an organic compound comprising ..." to address the §112 issue at lines 132-133. Claim 1 is further amended at line 114 by replacing the word "the" with the word --and--. Finally, claim 1 is further amended at lines 143-144 by deleting the words "(cylinder head sheet gasket or cylinder head/engine block interface." Claim 4 is amended by replacing the words "in that" with the word --wherein--. Claim 5 is amended to read, in part, "... wherein the polyorganosiloxane is an epoxy silicone and/or a vinyl ether silicone which is ..." Claim 6 is amended to read, in part, "... wherein the polyorganosiloxane is an epoxy silicone having a formula selected from the group consisting of (A.1), (A.2) and (A.3):." Claim 9 is also amended by deleting the words "of the type of those" and by inserting a comma and a line between "crosslinkable silicone compositions and compositions which are precursors of silicone elastomers." Finally, Applicants have added new claims 10 and 11 to further define exemplary embodiments of the invention. Support for new claims 10 and 11 can be found at least at original claim 1, line 22 and lines 143-144, respectively.

Turning now to the Official Action, the Abstract of the Disclosure stands objected to for being in improper form. In order to obviate the objection, Applicants have provided the above new Abstract.

In view of the above new Abstract, Applicants respectfully request reconsideration and withdrawal of the objection.

Claims 1 to 9 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

With respect to the rejection of claims 1, 4, 5, 6, 7 and 9 for including various symbols, Applicants have amended the claims to remove the extraneous symbols. As these amendments were made only to enhance readability of the claims, they cannot be considered narrowing amendments for purposes of patentability.

With respect to the rejection of claim 1 for use of the phrase "group consisting essentially of" in lines 8-11, Applicants have amended claim 1, as suggested by the Examiner, to include the words --and mixtures thereof--.

With respect to the rejection of claim 1 for use of the words "formed by" a "borate of an onium ... or of an organometallic complex ...," in lines 12-15 of claim 1, Applicants provide the following remarks. Applicants submit that this portion of claim 1 particularly points out and distinctly claims the subject matter which the Applicants regard as their invention. That is, because the scope of the subject matter embraced in this portion of claim 1 is clear, and Applicants have not otherwise indicated that they intend the claim to be of different scope, this portion of claim 1 particularly points out and distinctly claims the subject matter which Applicants regard as their invention. See In re Borkowski, 422 F.2d 904, 164 USPQ 642 (CCPA 1970).

Furthermore, the Federal Circuit has had the opportunity to decide a number of §112, second paragraph, issues. From these cases, it is clear that definiteness of claim

language must be analyzed, not in a vacuum, but in light of (1) the content of the particular application disclosure, (2) the teachings of the prior art, and (3) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See, for example, In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). The purpose of claims is not to explain the technology for how it works, but to state the legal boundaries of the patent grant. A claim is not "indefinite" simply because it is hard to understand when viewed without benefit of the specification. See S3 Inc. v. nVidia Corp., 259 F.3d 1364, 59 USPQ2d 1745 (Fed. Cir. 2001).

Applicants submit that the meaning of "initiator salt (PI) formed by a borate of an onium of an element from groups 15 to 17" is clear when read in light of the content of the application's disclosure, the teachings of the prior art and when interpreted by those possessing the ordinary level of skill in the art. (See specification at page 25, lines 14-18.) Specifically, one of ordinary skill in the art having read the disclosure at page 25, would readily understand what the legal boundaries of claim 1 are. That is, one of ordinary skill in the art, having read the disclosure at page 25, would understand that the initiator is one derived from an onium borate or organometallic salt borate. Additionally, the disclosure at page 33 provides further guidance to those of ordinary skill in the art by identifying exemplary onium borates, which are disclosed in European Patent Application EP-A-0562922 or application PCT/WO-A-98/29498. Moreover, the disclosure at page 33, line 22 to page 34, line 4 further states that initiators that can be used in the invention are prepared in a very simple way by dissolution of an onium borate or organometallic complex borate, preferably onium borate, which are provided in solid (powder) form, in a

solvent. Thus, in view of this additional disclosure in the specification, Applicants submit that those of ordinary skill in the art having read the disclosure of the instant application would be readily able to determine the legal boundaries of claim 1.

Accordingly, Applicants submit that because one skilled in the art would be able to tell with a reasonable degree of certainty whether his or her conduct is within or outside the scope of claim 1, claim 1 is neither vague nor indefinite. See In re Borkowski.

With respect to the rejection over a lack of antecedent basis for "the cationic entity of said borate," Applicants have amended the claim at line 16 to obviate the rejection. In particular, Applicants have replaced the word "the" with the word --a--.

With respect to the rejection of claim 1 for use of the words "onium salts", "oxoisothiochromanium salts", "sulfonium salts" and "organometallic salts" Applicants submit that these terms are also clear when read in view of the specification. In particular, the disclosure at page 15, line 17 to page 22, line 4, which corresponds to the language in claim 1 is believed to be sufficient for one of ordinary skill in the art to understand what the legal boundaries of claim 1 are. In particular, Applicants believe that the chemical formulae disclosed in claim 1 and in the corresponding specification would enable one of ordinary skill in the art to be able to tell with a reasonable degree of certainty whether his or her conduct is within or outside the scope of claim 1. Thus, Applicants submit that this language is neither vague nor indefinite. See In re Borkowski.

With respect to the rejection of claim 1, line 22 for including the words "it being possible for", Applicants have amended the claim by deleting the words "it being possible for said heterocyclic radical to comprise nitrogen or sulfur as heteroelements."

With respect to the rejection of claim 1, line 49 for use of the word "or," Applicants have replaced "or" with --and--.

With respect to the rejection of the language in line 58 of claim 1, Applicants have canceled the words "additional conditions according to which" and inserted --proviso that--, as suggested by the Examiner.

With respect to the rejection of the language in line 61 of claim 1, Applicants have canceled "Y¹" and inserted --Y¹-- so that the claim reads, in part, "... monovalent radical representing the group of formula Y¹: ..."

With respect to the rejection of the language in line 76 "the possibility of being connected to," Applicants have amended the claim, as suggested by the Examiner, to read, in part, "... in addition to the meanings given above, are optionally connected to one another via the Y'"

With respect to the rejection of the language in line 79 to 80, Applicants have amended claim 1 to read, in part, "... a divalent residue selected from the group of residues recited in the definition of Y⁴."

With respect to the rejection of the language "and/or" in line 83, Applicants have amended the claim to read in part "... and a monosulfonium species having a single S⁺ ..."

With respect to the rejection of the language in line 97 of claim 1, Applicants have deleted the word "and" and added a comma so that the claim reads in part "... cyclopentadienyl, η^7 -cyclo-heptatrienyl ligands ...

With respect to the rejection of the language in lines 132 to 133, Applicants have amended the claim to read, in part, "... at least one reactive diluent selected from the group consisting of a nonorganosilicon, an organosilicon and an organic compound"

With respect to the rejection of the language in claim 1, line 114, Applicants have replaced the word "the" with the word --a-- to address the antecedent basis issue with respect to "the anionic entity borate."

With respect to the rejection of the language at lines 143-144, Applicants have deleted the words "(cylinder head sheet gasket or cylinder head/engine block interface)."

With respect to the rejection of claim 4 for use of the words "in that the functional units included in," Applicants have amended claim 4 to read, in part, "... and wherein the functional units included in the optional SFG groups"

With respect to the rejection of claim 5 for not providing antecedent basis for "POs A are epoxysilicones and/or vinyl ether silicones," Applicants have amended claim 5 to read in part "... wherein the polyorganosiloxane is an epoxysilicone and/or a vinyl ether silicone which is"

With respect to the rejection of claim 6 for failing to provide antecedent basis for "POs A are epoxysilicones," Applicants have amended claim 6 to read, in part, "... wherein the polyorganosiloxane is an epoxysilicone having a formula selected from the group consisting of."

With respect to the rejection of claim 9, Applicants have deleted the words "of the type of those" so that the claim reads, in part, "... is covered using an adhesion primer comprising at least one compound selected from the group consisting of."

Additionally, Applicants have added a comma after the word "composition" so that the claim also reads in part "... crosslinkable silicone compositions, and compositions which are precursors of silicone elastomers."

In view of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the §112, second paragraph, rejections.

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as being obvious over FR 2757870 (FR '870) in view of EP 0522703 (EP '703). For at least the reasons that follow, withdrawal of the rejection is in order.

As stated by the Federal Circuit, evidence rising out of the so-called secondary considerations must always, when present, be considered on route to a determination of obviousness. Indeed, evidence of secondary considerations can often be the most probative and cogent evidence in the record. It can often establish that an invention appearing to have been obvious in light of the prior art was not. See Stratoflex Inc. v. Auroquip Corp. 218 USPQ 871, 879 (Fed. Cir. 1983); Joy Technologies v. Quigg, 14 USPQ2d 1432, 1444 (DDC 1990).

Applicants submit that in the present case, there is no appreciation in either of the cited references, alone or in combination, of the unexpected and surprising advantages obtained by the claimed process. In particular, Applicants submit that the cited references, even in combination, fail to disclose or suggest that one could prepare a coating which provides sufficient release and is leaktight at the engine block/cylinder head interface of engines, wherein the coating exhibits the surprisingly superior solvent and scratch resistance of the coating made by the claimed process.

In particular, Applicants have conducted the following comparative test to demonstrate that the unexpected and surprisingly superior properties of products made using the claimed process would not be achieved by conventional coating processes such as that described in FR '870. The following comparative tests were conducted in accordance

with Example 2 described at page 52 of the specification. In particular, 30 g/m² of the same formula used in Example 2 with a different weight ratio of component C (1,4-cyclohexanedimethanol divinyl ether, equal to reactive diluent C) was applied in the same way as in Example 2 and compared with a coating which was applied with 0 weight % of component C. The combined properties measured are collated in the following table:

	Test 1 Comparative	Test 2 Invention	Test 3 (Ref) Invention
% Weight Ratio of Component C	0	10	20
Thickness	30 μ m	30 μ m	30 μ m
Color	Black	Black	Black
Crosslinking Conditions	UV crosslinking	UV crosslinking	UV crosslinking
Max. Rate	10 m/min	10 m/min	10 m/min
MEK (methyl ethyl ketone) (1) solvent resistance expressed as a ratio: Test 1/Test 3	0.16	0.7	1
Scratch Test (4) expressed as a ratio: Test 1/Test 3	0.5	0.8	1

The above test data shows that a 6.25-fold improvement in solvent resistance (i.e., MEK (methyl ethyl ketone)) was observed and a 2-fold improvement in scratch resistance was observed in the products made using the process of the present invention as compared to the comparative product made without any of Component C.

Thus, even if the Official Action had established a *prima facie* showing of obviousness, Applicants submit that the unexpected results achieved by the claimed process would rebut such a showing. Accordingly, the rejection under 35 U.S.C. §103(a) should be withdrawn.

Claims 1-9 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-13 of U.S. Patent No. 6,423,378. Because the pending claims are still under consideration, Applicants respectfully request that the Examiner hold this rejection in abeyance until there has been an indication of allowable subject matter. Applicants submit that when an indication of allowable subject matter is made, they will be able to determine if a response is warranted.

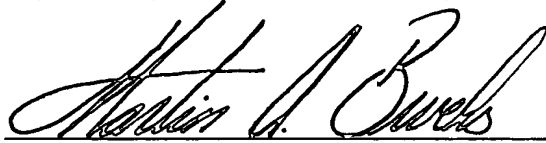
From the foregoing, Applicants earnestly solicit further and favorable action in the form of a notice of allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

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